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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,503	01/25/2002	David C. Issler	10294-607001	4327

7590 02/09/2005

ST. ONGE STEWARD JOHNSON & REENS LLC  
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STAMFORD, CT 06905-5619

EXAMINER
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STASHICK, ANTHONY D

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/057,503

**Applicant(s)**

ISSLER, DAVID C.

**Examiner**

Anthony Stashick

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on December 6, 2004, filing of RCE.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14, 16-22, 24, 25 and 27-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14, 16-22, 24, 25 and 27-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 6, 2004 has been entered.

### ***Drawings***

2. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on September 5, 2003 have been accepted. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-4, 7, 18-20 and 27-28 are rejected under 35 U.S.C. 102(b) as being anticipated by McClelland 5,775,005. McClelland '005 discloses all the limitations of the claims including the following: an outsole assembly (see Figures 3 and 4) with a heel region having an inner surface,

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an outer surface adapted to be in contact with a walking surface and an opening 62 extending from the inner surface to the outer surface; a footbed 22 positioned over an area of the inner surface of the heel region; a plug 30 placed in the opening for enhancing comfort; the footbed is formed of a material having a first hardness that is less than an outsole material having a second hardness (pad 22 is formed of EVA or other flexible resilient materials while outsole body 24 is manufactured from an opaque natural or synthetic resin that is durable and oil resistant); the plug is formed of a material having a first hardness characteristic that is less than an outsole material having a second hardness characteristic (see above); the footbed and the plug are formed of a material having substantially the same hardness characteristic (footbed and plug both are formed of resilient material); the opening is positioned in a heel region of the inner surface of the heel region (see Figure 3); providing a heel region having an inner surface and an outer surface adapted to be in contact with a walking surface (see Figures 3-4); extending an opening from the inner surface to the outer surface (see Figure 3); positioning a footbed over an area of the inner surface of the heel region (see Figure 4, footbed 22 is positioned over the heel region); placing a plug 30 in the opening for enhancing comfort; forming the footbed 22 using a material having a first hardness characteristic that is less than an outsole material having a second hardness characteristic (see descriptions of outsole 24 and footbed 22); forming a plug 30 using a material having a first hardness characteristic that is less than an outsole 24 material having a second characteristic (see descriptions of outsole 24 and plug 30);; the footbed is formed of a material having a first hardness characteristic that s less than an outsole material having a second hardness characteristic (see descriptions of footbed 22 and outsole 24); footbed 22 extending over an entire inner surface of the sole (see Figure 4).

*Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 5, 6, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over McClelland 5,775,005 as applied above in view of Design Choice. McClelland '005 as applied above discloses all the limitations substantially as claimed except for the specific hardness of the material used for the outsole, footbed and plug. It appears that it would have been a mere matter of design choice to choose the hardness of the material to be used for the footbed, plug and outsole to meet the desired function of cushioning the user's foot upon impact and durability of the sole. Therefore, it would have been obvious, and well within the skill of one of ordinary skill in the art, at the time the invention was made, to make the footbed, plug and outsole out of a material made of any desired hardness to aid in cushioning the user's foot and preventing wear of the outsole as desired.

7. Claims 8-14, 16-17, 24-25 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over McClelland 5,775,005 as applied to claims 1 and 8 above in view of Lober 844,882. McClelland '005 discloses all the limitations of the claims except for the plug having a cap section and a pedestal with a lip being formed by the cap, the plug having first and second protrusions with different peripheries with the second protrusion being attached to the first protrusion and having a periphery larger than the periphery of the first protrusion. Lober '882

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teaches that a plug depending from the bottom surface of a footbed and fitted within the opening of a sole can have a pedestal b and cap b' with the cap forming a lip extending past the perimeter of the pedestal. The lip of the cap preventing accidental removal of the plug from the opening of the sole. Therefore, it would have been obvious to make the plug of McClelland '005 as applied to claims 1 and 8 above with a pedestal and cap, as taught by Lober '882, to aid in holding the plug in the opening and prevent accidental removal of the plug from the opening. With respect to the perimeters of the cap and pedestal, Lober '882 meets these limitations in as much as that which is shown and disclosed by the applicant. With respect to claim 29, Lober '882 teaches that a plug can depend from the bottom surface of a footbed and be fitted within the opening of a sole; the plug can have a pedestal (first protrusion b) and cap (second protrusion b') with the cap forming a lip extending past the perimeter of the pedestal. The lip of the cap prevents accidental removal of the plug from the opening of the sole. Therefore, it would have been obvious to make the plug of McClelland '005, as applied to claim 28 above, with a pedestal, as taught by Lober '882, to aid in holding the plug in the opening and preventing accidental removal of the plug from the opening.

### ***Response to Arguments***

8. Applicant's arguments with respect to all the claims have been considered but are moot in view of the new ground(s) of rejection.

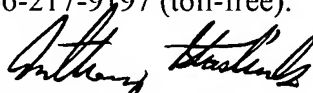
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*Conclusion*

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is (571) 272-4561. The examiner can normally be reached on Monday through Thursday from 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Anthony Stashick  
Primary Examiner  
Art Unit 3728

ADS